

Appl. No. 10/707,809

Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

### **REMARKS**

Reconsideration of the present patent application is respectfully requested. Claims 1-19, are pending in this application. By this amendment, claims 1, 5, 7, 14, 15 and 19 have been amended, claims 2, 3, 6, 9-11 and 18 have been canceled and claims 20-27 have been added as new claims.

#### **I. Objections Based on Informalities**

The specification and claims 2, 5, 6, 9, 14, 15 and 19 were objected to by the Examiner because of various informalities. The specification and claims 5, 14, 15, and 19 have been amended to address the Examiner's objections. The other claims that were objected to, namely claims 2, 6 and 9, have been canceled by this Amendment. To the extent that any of the claim language of the canceled claims has been included in new claims 20-27, the claim language has been corrected appropriately in light of the Examiner's objections.

#### **II. Rejection Under §102 - Ryan et al.**

The office action has rejected claims 1, 2 and 6 under 35 U.S.C. 102(b) as being anticipated by Ryan et al. (United States Patent No. 5,782,116). Claim 1, as currently amended, recites, in pertinent part,

"a rail projecting from the outer surface of the circumferential wall of said inner piece; and  
a track formed within the inner surface of the circumferential wall of said outer piece, wherein said rail slides along said track to provide telescopic movement of said inner and outer pieces"

Ryan et al. does not disclose a rail projecting from the outer surface of the circumferential wall of its inner shell (26) or a track formed within the inner surface of the circumferential wall of its outer shell (20). Instead, Ryan et al discloses an outer shell (20) having a reinforcing bead (22) which is received in a groove (23) of a bead (24) of the inner shell (26). Since Ryan et al.

Appl. No. 10/707,809

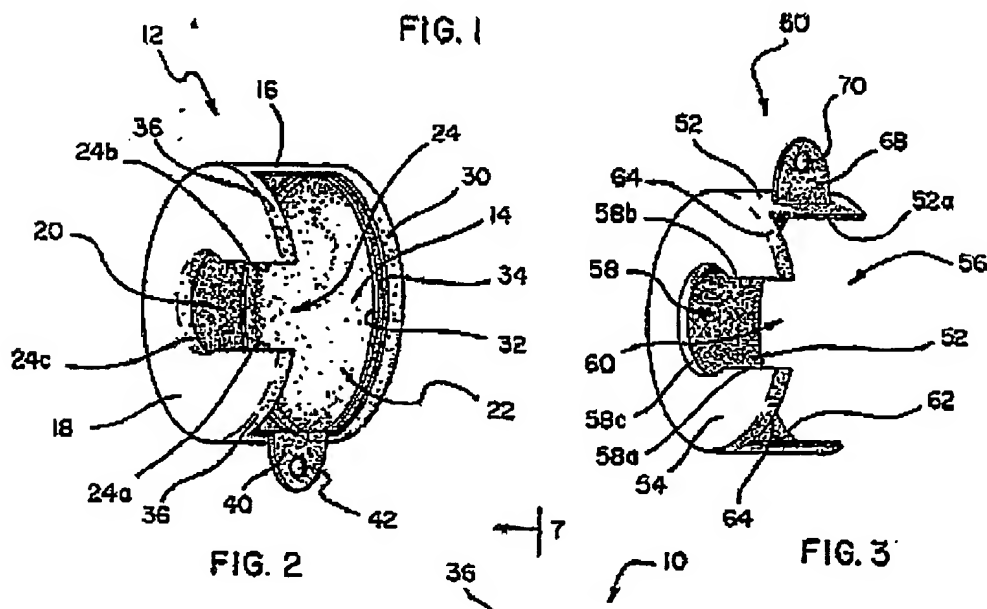
Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

does not include each and every element of claim 1, as currently amended, claim 1 is not anticipated by Ryan et al. Reconsideration of this rejection is respectfully requested.

### III. Rejection Under §102 - Gilbert

The office action has rejected claims 1-8, 12, 13 and 17 under 35 U.S.C. 102(b) as being anticipated by Gilbert (United States Patent No. 4,899,564). Claim 1, as amended, recites that that the inner and outer piece of the lockout device are "formed in the shape of half cylinders." Gilbert does not disclose inner and outer pieces in the shape of half cylinders. As can be seen below in Figs. 2 and 3 of Gilbert, the outer housing (12) of Gilbert is formed in the shape of substantially a whole cylinder having two end walls and a side wall with portions cut away. The closure panel (50) of Gilbert is also not a half cylinder, but, rather, an end wall of a cylinder and a side wall with portions cut away. As Gilbert does not disclose an inner and outer piece that are "formed in the shape of half cylinders," it does not anticipate claim 1, as currently amended.



United States Patent No. 4,899,564 - Figures 2 and 3

Appl. No. 10/707,809

Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

In addition, **claim 1**, as currently amended, recites, in pertinent part,

“a rail projecting from the outer surface of the circumferential wall of said inner piece; and  
a track formed within the inner surface of the circumferential wall of said outer piece, wherein said rail slides along said track to provide telescopic movement of said inner and outer pieces”

Gilbert does not disclose a rail projecting from the outer surface of the circumferential wall of its closure panel (50) or a track formed within the inner surface of the circumferential wall of its outer housing (12). As illustrated above in Fig. 2 of Gilbert, a groove (34) is formed within the outer housing (50) of Gilbert. This groove is not formed in the circumferential wall of the housing (50), but, rather, is formed within one of the side walls of the housing. Finally, as shown in Fig. 3 of Gilbert, the closure panel (50) of Gilbert does not have a “rail projecting from the outer surface of [its] circumferential wall.” Rather, the edge of the closure panel (50) itself actually fits within the groove (34) formed within the outer housing (50). As Gilbert does not disclose each element of **claim 1**, as currently amended, it does not anticipate **claim 1**. Therefore, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

**Claim 7**, as currently amended, recites, in pertinent part,

“an inner piece including a rail, said rail being T-shaped; and  
an outer piece including a track, wherein said rail slides along said track to move said lockout device to and from a closed position and an open position.”

Gilbert does not disclose a T-shaped rail that slides along a track. As shown in Fig. 3 of Gilbert above, the actual edge of the closure panel (50) is what slides along the groove (34) formed within the outer housing. The edge of Gilbert's closure panel (50) is not T-shaped. Clearly, Gilbert does not disclose each element of **claim 7**, as currently amended, and thus does not anticipate **claim 7**. Accordingly, reconsideration of this rejection is respectfully requested.

In addition, **claim 7**, as currently amended, incorporates the limitations of **claim 9**, which was rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Wilk (United States Patent No. 5,016,772). For the following reasons, **claim**

Appl. No. 10/707,809  
Amdt. dated December 10, 2004  
Reply to Office action of September 10, 2004

7, as currently amended, should not be rejected as unpatentable over Gilbert in view of Wilk. As discussed previously, Gilbert does not anticipate claim 7, as currently amended, because it does not disclose each limitation of the claim. In addition, the failure of Gilbert to disclose each element of claim 7, can not be cured by combining Gilbert with Wilk.

Gilbert includes an outer housing (12) with a groove (34) that extends "without interruption circumferentially inside the side wall (16) and contiguous flange (30)" as illustrated above in Figure 2 of Gilbert. The edge of the closure panel (50) is able to fit into and slide within this groove (34). Wilk discloses a T-shaped lug (50) which slides within a T-shaped groove (48). If the groove (34) of Gilbert, that extends "without interruption circumferentially inside the side wall" were modified so as to be T-shaped and the edge of the closure panel (50) were also modified to be T-shaped, the closure panel would not be able to fit within the groove. The fact that the groove (34) extends "without interruption" would prevent the T-shaped edge from fitting into the groove. A combination of Gilbert and Wilk would not be functional. Accordingly, claim 7, as currently amended, is not rendered unpatentable over Gilbert in light of Wilk.

Furthermore, most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

No such motivation, suggestion or teaching of the desirability of combining the T-shaped lug (50) and groove (48) of the collapsible container of Wilk with the doorknob security device

Appl. No. 10/707,809

Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

of Gilbert can be found in the disclosure of either Gilbert or Wilk. These references concern entirely different art units, namely containers and security devices, that have nothing to do with each other. There is no mention in either of the references why anyone would desire to combine the rail system of the collapsible container of Wilk with the doorknob security device of Gilbert. As there is no motivation to combine the elements from these references, claim 7 is also not rendered unpatentable over Gilbert in light of Wilk for this reason.

#### IV. Rejection Under §103 - Gilbert & Wilk

The office action has rejected claims 9-11 and 19 under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Wilk (United States Patent No. 5,016,772). For the reasons listed below, Applicant respectfully disagrees with these rejections. Claims 9 -11 have been canceled by this Amendment. The Applicant respectfully disagrees with the Examiner's finding that claim 19 is unpatentable over Gilbert in view of Wilk.

Firstly, claim 19, as currently amended discloses "an interior close ended half cylinder nested within an exterior closed ended half cylinder." As discussed above, Gilbert does not disclose inner and outer pieces in the shape of half cylinders. The outer housing (12) of Gilbert is formed in the shape of substantially a whole cylinder having two end walls and a side wall with portions cut away. The closure panel (50) of Gilbert is also not a half cylinder, but, rather, a section of a cylinder consisting of an end wall and side wall with portions cut away. As Gilbert does not disclose an inner and outer piece that are "closed ended half cylinder[s]," it does not include every element of claim 19, as currently amended.

Secondly, claim 19, as currently amended, also recites,

"a T slot comprising a T slot track formed in the *inner surface of the circumferential wall* of the exterior half cylinder and a T slot rail attached to the *outer surface of the circumferential wall* of the interior half cylinder, wherein the T slot rail slides into and out of the T slot track when the lockout device is moved between a closed position and an open positions" (emphasis added)

As discussed above, Gilbert does not disclose a rail projecting from the outer surface of the circumferential wall of its closure panel (50) or a track formed within the inner surface of the

Appl. No. 10/707,809

Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

circumferential wall of its outer housing (12). The outer housing (50) of Gilbert has a groove formed within it, but this groove is formed within one of the side walls of the housing and not in the circumferential wall of the housing (50). The closure panel (50) of Gilbert does not have a rail projecting from the outer surface of its circumferential wall. Gilbert does not have a rail at all, rather, the edge of the closure panel (50) itself actually fits within the groove (34) formed within the outer housing (12). These are two additional elements of **claim 19**, as currently amended, that are not taught by Gilbert.

Thirdly, as discussed previously Gilbert does not disclose the T-shaped rail and track recited in **claim 19**, as currently amended. Rather, the groove (34) of Gilbert is simply a slot formed in the side wall of the outer housing (12) and the edge of the closure panel (50), which is clearly not T-shaped, fits into and slides within the groove.

Finally, **claim 19**, as currently amended, recites

“an interlock attached to one end of the T slot, comprising a bar crossmember disposed on the T slot rail and one or more portions of the edges of the T slot track that extend inward into the track, wherein the bar crossmember contacts said one or more extended portions when the interior half cylinder is fully telescoped out of the exterior half cylinder to place the device in the closed position

Gilbert, clearly does not disclose any such interlock. No crossmember is disposed on the edge of the closure panel (50) of Gilbert. Furthermore, the groove (34) formed in the outer housing (12) of Gilbert has a uniform defined edge with no portion of the edge extending inward into the track.

Accordingly, Gilbert fails to teach the following five elements recited in **claim 19** as currently amended:

1. inner and outer pieces formed in the shape of closed ended half cylinders;
2. a track formed in the inner surface of the circumferential wall of the exterior half cylinder
3. a rail attached to the outer surface of the circumferential wall of the interior half cylinder;
4. the rail and track being T-shaped; and

Appl. No. 10/707,809

Amdt. dated December 10, 2004

Reply to Office action of September 10, 2004

5. an interlock including a crossmember disposed on the T slot rail and one or more portions of the edges of the T slot track that extend inward into the track.

A combination of Gilbert and Wilk does not correct these deficiencies. As discussed above, a modification of the groove (34) and closure panel (50) of the device disclosed in Gilbert to include the T-shaped grooves (48) and lug (50) of Wilk would be inoperable.

Likewise, a combination of Gilbert and Wilk would not correct the failure of Gilbert to teach the interlock recited in claim 19. The Examiner asserts that the slot (48) of Wilk includes end edges, which limit the sliding travel of the rail 50 in the slot. While Wilk has these end edges, it does not teach the "portions of the edges of the T slot track that extend inward into the track" which the crossmember of the rail contacts. No portion of the rail (50) of Wilk contacts a portion of the edge of the slot (48) that extends inward.

Even if a combination of Gilbert and Wilk taught a T-shaped slot and rail and interlock, such a combination would still fail to teach inner and outer pieces formed in the shape of closed ended half cylinders, a track formed in the inner surface of the circumferential wall of the exterior half cylinder, and a rail attached to the outer surface of the circumferential wall of the interior half cylinder, all of which are elements included in claim 19, as currently amended.

Finally, if it were true that Gilbert and Wilk together taught each element of claim 19, as currently amended, no motivation, suggestion or teaching of the desirability of combining the elements of Wilk and Gilbert exists. These references concern entirely different art units, namely containers and security devices, that have nothing to do with each other. There is no mention in either of the references why anyone would desire to combine the rail system of the collapsible container of Wilk with the doorknob security device of Gilbert. For these reasons, Applicant respectfully requests that the Examiner's rejection of claim 19, be reconsidered and withdrawn.

Appl. No. 10/707,809  
Amdt. dated December 10, 2004  
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**V. New Claims:**

Applicant respectfully submits that new **claims 20 - 27** are patentable over the prior art cited by the Examiner for the reasons above and are in condition for allowance.

**VII. Conclusion:**

Based on the foregoing remarks and amendments, Applicant believes that all of the claims in this case are now in condition for allowance and an indication to that effect is respectfully requested. Furthermore, if the Examiner believes that additional discussions or information might advance the prosecution of this case, the Examiner should feel free to contact the undersigned at the telephone number indicated below. It is believed that there is no fee associated with the filing and consideration of this amendment. **Should the Commissioner decide that any fee or fee deficiency is due, however, the Commissioner is hereby authorized to charge any and all fees incurred as a result of entering this amendment and response to deposit account number 03-0172.**

Date: 3/24/05

Respectfully submitted,

By: 

Ryan W. Falk, Reg. No. 54,090  
(216) 622-8206